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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,565	09/29/2003	Yoichi Kodama	018765-144	4272

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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,565

Applicant(s)

KODAMA ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. The prior art rejections have been withdrawn based on the applicant's amendments. However, new prior art rejections have been provided as necessitated by amendment. Also, the objection to the specification has been maintained since no correction was provided.

Specification

2. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamaya et al. Yamaya et al. (US 4,987,207) can be found on the applicant's Form PTO-1449.

5. Yamaya discloses thermosetting resins comprising a polyimide and a bismaleimide (abstract), where the bismaleimides of formula (III) fit the applicant's formula (1) (col. 2; examples).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaya et al. in view of Matsuura et al. (US 5,508,357).

8. Yamaya applies as above, teaching the combination of polyimides and bismaleimides applied to glass and metal plates but failing to teach the compositions applied to metal foils or polyimides and metal foils. Matsuura teaches similar polyimide/bismaleimide thermosetting compositions, where the materials are applied to metal foils and as adhesives between polyimide films and metal foils (col. 11 lines 51-62; col. 12 lines 34-63). The articles are formed to provide substrates for flexible printed circuit boards or TAB tapes. It is the examiner's position that it would have been prima facie obvious to use the polyimide/bismaleimide compositions of Yamaya's invention applied to metal foils or between polyimide films and metal foils to form substrates for flexible printed circuit boards or TAB tapes having Yamaya's improved toughness, flexibility, adhesion, and heat resistance properties.

9. Regarding the limitations drawn to the polyimide, Yamaya teaches polyimides fitting the claimed formulas (1) and (4) (col. 1 line 54-col. 2 line 30; examples).

10. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuura et al. in view of Yamaya et al.

11. Matsuura teaches thermosetting blends of polyimide and bismaleimide (abstract), where the preferred polyimides fit the applicant's formulas (1) and (4) (col. 3 lines 16-53). The materials are applied to metal foils or between polyimide films and metal foils

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(col. 11 lines 51-62; col. 12 lines 34-63). However, the bismaleimides exemplified having three phenyl groups do not have the claimed radical for X (col. 9). Yamaya teaches similar polyimide/bismaleimide thermosetting materials, where the bismaleimides contain 2-4 phenyl groups and have linking groups of oxygen, direct bonds, carbonyl groups, sulfonyl groups, and sulfinyl groups (col. 2 lines 32-68). The examples indicate that those materials made with compounds fitting the applicant's formula have lower softening points and higher tensile shear strengths than those made with N,N'-diphenylmethane bismaleimide, a compound exemplified by Matsuura (Yamaya, table 1; Matsuura, example 4). It is the examiner's position that it would have been prima facie obvious to use the bismaleimides of Yamaya's invention in Matsuura's invention to provide improved tensile shear strengths and lower softening points to the compositions.

Response to Arguments

12. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett

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Patent Examiner
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